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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/918,944 08/25/97 SAWYER

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EXAMINER

SAGER, M

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

08/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/918944

Applicant(s)

Sawyer et al

Examiner

M Sager

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on May 7 and 21, 1999

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 22-47 ☒ is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-47 ☒ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 31-32 and 44-47 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Forte et al. The phrase 'for controlling... number of bonus points' (clms 22 and 31) is a preamble which fails to breath life and meaning since the language is not essential to point out the invention and the language fails to limit the structure. However, for examination purposes the phrase is treated herein. Forte discloses a game and method for tracking an auxiliary game from a device for controlling progress of an incentive game (figs. 1-21), the card game including a bonus event (3:50-5:30), the auxiliary game providing an option to select (5:20-25) to receive a bonus point upon the occurrence of a bonus event (4:3-28), each player has a number of bonus points (figs. 1-21), where one of player is provided a prize upon accumulating a number of bonus points (4:53-5:15), where the device comprises a plurality of player interface units to display the number of bonus points accumulated by the player (figs. 1-21) and a controller coupled to the interface units to control the display (figs. 1-21), where the auxiliary game is counting natural blackjack hands and the option to select is player's indicating their desire to participate and have natural blackjack hands counted by their input of a wager/ ante (5:20-25).

Alternatively, where the auxiliary game is the well known Ten Stix 21 game, Forte discloses a game and method which shows it is known to automate the tracking and displaying of auxiliary/bonus events for easing the record keeping responsibilities of the dealer. Therefore, it would have been obvious to an artisan of gaming to automate the tracking and displaying of auxiliary events of Ten Stix 21 as taught by Forte in order to ease the record keeping responsibilities of the dealer.

Claim Rejections - 35 USC § 103

3. Claims 22-30 and 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al in view of Baerlocher et al. Forte discloses a game and method teaching claimed steps/features (supra) except 'generating a random prize' (clm 22), 'providing... option to play... tier' (clms 24 and 33), 'providing an option... game' (clms 25 and 34), 'occurs at least once... cards' (clm 26), 'selecting... prizes' (clm 27), 'associated probability of selection' (clms 28 and 40), 'receiving a dealer input... prize' (clm 30), 'at least one preventive event,... game' (clm 35), 'bust event, ... event' (clm 36), 'player control element,... players' (clm 37), 'selected from... predetermined prizes' (clm 38), 'randomizer... prizes' (clm 39).

Regarding the random prize steps/features (clms 22, 27-28, 30, 37-40), Forte discloses fixed prize levels. Baerlocher and Place each disclose apparatus for randomizing prizes comprising 'generating a random prize', 'selecting... prizes', 'associated probability of selection', 'receiving a dealer input... prize', 'player control element,... players', 'selected from... predetermined prizes', 'randomizer... prizes' in order to increase player enjoyment. Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'generating a random prize', 'selecting... prizes', 'associated probability of selection', 'receiving a dealer input... prize', 'player control element,... players', 'selected from... predetermined prizes', 'randomizer... prizes' as disclosed by each Baerlocher and Place to Forte's game and method in order to increase payer enjoyment.

Alternatively, regarding player input and dealer input steps/features (clms 30, 37-38), it is well known in gaming that involving the player in game events increases player excitement/enjoyment of the game and that the dealer/croupier is responsible for controlling game events. Therefore, it would have been obvious to an artisan of gaming to add 'receiving a dealer input... prize', 'player control element,... players' and 'selected from... predetermined prizes' as known in the art to Forte's game and method in view of Baerlocher or Place in order to increase player participation and excitement while maintaining dealer/croupier control.

Alternatively regarding steps/features of claims 24-26 and 33-36, where the auxiliary game is the well known Ten Stix 21 game, Forte discloses a game and method which shows it is known to automate the tracking and displaying of auxiliary/bonus events for easing the record keeping responsibilities of the dealer. Therefore, it would have been obvious to an artisan of gaming to automate the tracking and displaying of auxiliary events of Ten Stix 21 as taught by Forte in order to ease the record keeping responsibilities of the dealer. Further, alternatively, the differences between the claimed steps/features and that which are clearly taught by Forte in view of either Baerlocher or Place lie in the type of known auxiliary game played. As the steps/features of the auxiliary game Ten Stix 21 are well known as being played with a card game which requires

counting of bonus events like the counting of bonus events accomplished by Forte, such features are variations of implementation of auxiliary games as are known and would have been obvious to one of ordinary skill in the art in implementing Forte's game and method in view of either Baerlocher or Place. Absent criticality, specific choice of auxiliary game falls within the realm of choice by game designers, when implementing the auxiliary game onto Forte's game and method in view of Baerlocher or Place. Therefore, it would have been obvious at the time the invention was made to add Ten Stix 21 auxiliary game as known and equivalent to Forte's game and method in order to provide an alternative auxiliary game for player enjoyment.

Response to Arguments

4. Applicant's arguments filed May 7 and 21, 1999 have been fully considered but they are not persuasive. First, the applicants are arguing patentability on a preamble phrase which is deemed to not breath life and meaning into the claimed invention (*supra*); however, the action has addressed the teachings of the art for that non-limiting language. Regarding applicant's asserted patentability for the feature of the auxiliary game providing an option to select to receive a bonus point is taught by Forte (*supra*) for the breadth of the language since the language fails to preclude the ante/wager of a player's selection to participate in Forte's auxiliary game as being an option to select to receive a bonus point in Forte's auxiliary game. Additionally/alternatively, it was further shown that it would be obvious to add the well known Ten Stix 21 auxiliary game to Forte's game and method in order to provide an alternative auxiliary game for player enjoyment (*supra*). Ten Stix 21 clearly includes the argued step for providing an option and Forte teaches the structure for automating the counting of bonus events in an auxiliary game.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The standard by which patentability is determined is what the combination taken as a whole would suggest to an artisan of gaming at the time the invention was made. In the instant case, Forte teaches including an auxiliary game to a card game played either at a card table with a dealer or on a gaming machine where the auxiliary game includes counting of a predetermined number of bonus events to occur for awarding a prize for each player who successively meets the prize conditions. Forte's game and method teaches a structure for the automated tracking of the bonus counts for all players. Forte does not teach/disclose randomizing prizes. Baerlocher and Place at least each teach randomizing prizes for increasing player excitement and enjoyment. Therefore, the combination to an artisan of gaming at the time the invention was made suggests an auxiliary game with counting of bonus events accomplished by structure taught by Forte with random prizes as taught at least by Baerlocher or Place in order to increase player excitement and enjoyment. Additionally, the auxiliary game of Ten Stix 21 was determined to be obvious to be added to Forte's game and method in order to increase player enjoyment by providing alternative auxiliary game. It is well known in gaming to provide a plurality of games or optional features in

order to allow for a player to select the game or game features (auxiliary games) they wish to play.

5. Applicant's arguments with respect to claims 22-47 have been considered but are moot in view of the new ground(s) of rejection. Place also teaches it is well known to randomize prizes in a game to increase player enjoyment and excitement.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bennett, Inoue, Watts, Bell-Fruit Manufacturing Co. Ltd., Arthur Edward Thoms Ltd. and Barcrest Ltd each disclose games, prize levels or randomizing of prizes considered pertinent.


7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

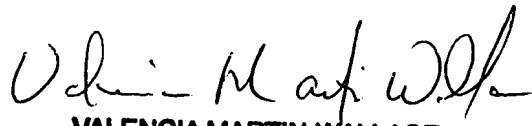
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


M. Sager
Patent Examiner
Aug. 4, 1999


VALENCIA MARTIN-WALLACE
PRIMARY EXAMINER